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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,853	11/02/2001	Ashok V. Joshi	4729US	7449

55162 7590 11/17/2006

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EXAMINER

DESANTO, MATTHEW F

ART UNIT PAPER NUMBER

3763

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,853

Applicant(s)

JOSHI, ASHOK V.

Examiner

Matthew F. DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/9/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 77-114 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 77-114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 77 is objected to because of the following informalities: there is a lack of antecedent basis for the term "said ionic fluid" in line 3 and in line 5. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 77-80, 82-86, 88-102, 112, 113 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. (USPN 7,031,768)

Anderson et al. teaches an iontophoresis method and apparatus for delivery of a beneficial agent comprising two electrodes (46, 48), which are electronegative or electropositive. The device further includes two semi-permeable membranes (62) and a conductor (which is a wire [50]) and wherein both electrodes are in direct contact with reservoirs (42, 44) that store ionic fluid. Contact of the membranes with the subject's tissue completes the circuit of the device and an alternative power source is not needed. Anderson further teaches a control circuit in another embodiment (see figure 10).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 87, 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. as applied to the claims above, and further in Sage Jr. et al. (USPN 6,584,349).

Anderson et al. disclosed the claimed invention, but failed to disclose adding a power supply to the iontophoretic device and coating or making one of the electrodes out of carbon.

Sage Jr, et al. discloses using galvanic means to transport a drug into the body, but also discloses using a power if necessary to provide further voltage, which will increase the force that the drugs will be able to penetrate the skin. Sage Jr, also teaches the use of carbon coated electrodes.

Therefore at the time of the invention it would have been obvious for one of ordinary skill in the art to combine the device of Anderson et al. with the teachings of Sage Jr. because Sage Jr., Sage JR discloses the usefulness of adding a power source if the galvanic means is not strong enough (Sage, Jr. Column 11), and with regards to use of a carbon electrode, this is a standard in the art due to the benefits of using carbon, which is taught throughout the Sage Jr. reference.

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5. Claims 81, 104-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. as applied to claims above, and further in view of Avrahami (USPN 6,615,079).

Anderson et al. discloses the claimed invention but fails to disclose a specific method of use of the device.

Avrahami discloses an electrotransport device that is used for delivering fluid into the eye, but more specifically into the stratum corneum skin layer. Avrahami discloses using his electrotransport device to delivery fluid from a reservoir when a current is sent through the electrodes.

Therefore, at the time of the invention it would have been obvious to use the device of Anderson et al. in medical procedure of Avrahami because Avrahami discloses a method of delivering treatment fluid to the eye and thus showing the level of skill in the art. Avrahami also discloses in the first paragraph of the background section, that it is well known in the art to use diffusion devices to transport drugs into the eye.

Response to Arguments

6. Applicant's arguments filed 8/9/06 have been fully considered but are moot because of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F. DeSanto whose telephone number is 571-272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew DeSanto
Art Unit 3763
November 13, 2006

A handwritten signature in black ink, appearing to read 'Matthew DeSanto', is located below the typed name and date.